

## **REMARKS**

Claims 1-9 are currently pending in the subject application and Claims 1-9 are presently under consideration.

### **I. Rejection under 35 USC § 103(a)**

In the same Office action mailed 07 September 2005, Claims 1-9 have been rejected under 35 USC 103(a) as being unpatentable over Michelson et al. (US 2004/0042612 A1) in view of Hammond (US 5,155,761).

In view of the present discussion, Applicant respectfully traverses the present rejection and requests reconsideration and allowance of the pending claims for at least one of the following reasons.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. None of references cited by the Examiner alone or in combination would have made the whole invention obvious over the prior art.

#### **US 2004/0042612 (to Michelson)**

Michelson describes a telephony system for processing incoming calls but does not deal with a call back situation. Further, Michelson does **not** teach the use of telephone text messaging. It mentions a cell phone, voice calls, emails, facsimile, chat room dialogue, instant messaging, and internet messages, but is completely silent on telephone

text messaging. There are some references to "text based communications" and "text messages" but it is clear from the context of the document that the writer is **not** talking about something akin to SMS or MMS messages, or any other type of text messaging, originating from telephones. It is clear from Michelson that the reference to text messages means email or web chat, and **not** telephone text messaging.

Michelson deals with what is called "skilled based routing" in the call centre industry. That means that the content of an inbound call is used to direct a call to a call centre agent with the relevant skills. For example, one may phone in to request help with one's modem. The word modem would be used by some automated system to get the caller to a service person with knowledge of modems. This is an altogether different concept to the Applicant's use of text message content to work out what company a message is for and then to determine when that company can call the "caller/texter" back.

#### **US 5,155,761 (to Hammond)**

Hammond describes a telephone system where incoming calls are dealt with by a robot controller (14) which lets a caller know of a call back time if a phone attendant is not available. A significant difference between Hammond and the applicant's claims is that Hammond only deals with regular voice calls and not telephone text messaging. Hammond involves a person calling via a landline – it is certainly only a voice call, and setting up a call back. The Applicant's invention is very different, involving inbound text messaging technology, which presents a completely new channel for call centres.

#### **Alleged Obviousness**

We respectfully remind the examiner that during prosecution of an application, the burden is initially upon the examiner to make a *prima facie* case of obviousness, and that the burden to rebut this only passes to the applicant once a *prima facie* case has in fact been made. We remind the examiner that a *prima facie* case is only made out if the

following conditions are met;

there is a suggestion within the cited references or the knowledge of a person of ordinary skill in the art to modify or combine the references to achieve the claimed invention;  
there was a reasonable expectation of success; and  
the prior art teaches all claim limitations.

As the examiner is aware, an applicant can rebut this by showing, among other things, that a person of ordinary skill in the art would not have used the cited prior art to make the invention because (1) prior art taught away from the solution reached in the invention, (2) there was no suggestion to combine the cited art, (3) there was no reasonable expectation of success, or (4) not all claim limitations are taught by prior art.

### **1) Teaching Away**

It is submitted that at the priority date in November 2002 there was an industry prejudice or teaching away from the use of text messaging in the context of call centers. This is evident from the enclosed affidavit of Mr Warren Tobin (see attached). The affidavit shows that text messaging was considered technically problematic on the basis that the technology was very much in its infancy and consequently there was no reasonable expectation that messages would get to their destination with a reasonable reliability (bearing in mind that missed calls are very undesirable in a call centre context). Unreliability of the technology means that call centers, which depend on reliable contact with callers, would not have considered a text message based system. The affidavit outlines various other reasons as to why the state of the art taught away from the invention as claimed at the priority date.

### **2) No Suggestion to Combine**

It is submitted that there is nothing within the cited prior art, or indeed elsewhere, which suggests or leads one to combine Hammond and Michelson. This situation is not

the case of one document posing a problem and the other posing a complimentary solution involving text messaging as per claim 1.

### **3) No Reasonable Expectation of Success**

As explained in the Tobin affidavit, there were serious concerns with text message technology at the priority date in that phone companies would not guarantee successful delivery of telephone text messages. We accordingly submit that there was no reasonable expectation that a telephone text message based call centre system would prove successful. Missed or lost calls are simply unacceptable in the context of a call centre solution or system.

### **4) The Prior Art does not Mention all Claim Limitations**

It is submitted the cited prior art does not mention all of the claim limitations. For example in the words of claim 1, there is nothing in either citation on “taking text messages at a call centre wherein such text messages are made by way of telephones. We believe it is non-contentious that the Hammond citation does not mention text messages made by way of telephones. The examiner has suggested that such messages are part of Michelson. We respectfully point out that while Michelson mentions “text based” communications, or “text messages”, it is clear from the context of the document that it is talking about emails, facsimile messages, internet chat room dialogue, and internet instant messaging using computers (see for example page 2 paragraph 0022). The claim clearly refers to making a message with a telephone, which is markedly different to simply sending a message via a telephone line. It is evident from Michelson that there was no thought of using telephone text messages, for example SMS or MMS messages. Michelson does refer to a cellular telephone, but there is absolutely no suggestion in the document that it is intended for anything other than a normal voice call.

In a rejection under 35 USC § 103(a), the Examiner bears the initial burden of establishing a prima facie case of obviousness. To establish a prima facie case of obviousness, there must be both some suggestion or motivation to modify the reference or

combine reference teachings and a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). It is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by appellants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor).

Accordingly, this rejection should be withdrawn.

### **CONCLUSION**

For all of the above reasons, Applicant submits that the pending claims are in proper form, and that the pending claims all define patentably over the prior art. Therefore, Applicant submits that this application is in condition for allowance. If a telephone conference would aid in the prosecution of this case in any way, the Examiner is invited to call the undersigned at 703-550-1968.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to deposit account No. 50-3321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-3321.

Respectfully submitted,

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